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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/587,600

08/02/2006

Yuriy Sergeyevich Bilivitin

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EXAMINER

FELTON, MICHAEL J

ART UNIT

PAPER NUMBER

1791

MAIL DATE

DELIVERY MODE

09/09/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/587,600	Applicant(s) BILIVITIN ET AL.	
	Examiner MICHAEL J. FELTON	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/12/2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 20-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 20-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/12/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 20-24, 32, 34, 36-38, 40, and 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Regarding claim 1, the phrase, "and installed so that at least a part of a second cavity of the mouthpiece is detachable from at least a part of the cavity of the mouthpiece," is unclear. The examiner believes that this portion of claim 1 is indicating that the empty mouthpiece can be moved relative to the envelope, allowing the volume of the cavity within the envelop to be changed.

4. The term "low" in claims 31-34, and 39 is a relative term which renders the claim indefinite. The term "low" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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6. Claims 1, 20, 21, 25-27, 35, 37 and 39-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Schut et al. (DE10044771 and English machine translation thereof).

7. Regarding claims 1, 20, 21, 25-28, 37, 41 Schut et al. disclose a telescoping cigarette system where the inner sleeve (figures 1-5, element 1) serves as the empty mouthpiece, an empty outer sleeve envelope (element 2) that can slide (i.e. overlap the mouthpiece) so that the cavity within the envelope can be varied (i.e. so that at least part of a second cavity of the mouthpiece is detachable from at least part of the cavity of the envelope). A perforated portion of the mouthpiece wall is crimped (i.e. a deformed part, or selectively penetrable partition) is shown by Schut et al. in figure 3 element 6, 6a, and 9, where it is shown blocking the tobacco (and allowing compression of the tobacco).

8. Regarding claim 35, Schut et al. disclose a filter in the mouthpiece (element 4).

9. Regarding claim 39 and 40, the empty mouthpiece and crimped paper tube of Schut et al. is inherently of a material with low sorption capability (i.e. air).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 22, 23, 29-31, 33, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schut et al. (DE10044771 and English machine translation thereof) as applied to claims 1 and 25 above, and further in view of Arneson (US 2,542,612).

14. Regarding claims 22, 23, 29, 30, and 35, although Schut et al. disclose using a perforated, crimped separating partition, the use of alternative partitions is not disclosed. However, it would have been obvious to one of ordinary skill in the art to use other means to physically separate the tobacco from the cavity in the mouthpiece that is conventional in Russian cigarettes. For instance, Arneson teach the use of a filtering

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element to prevent passage of crumbs of tobacco into the smokers mouth, the same problem being solved by the crimped section disclosed by Schut et al. Therefore, it would have been obvious to use the filters disclosed by Arneson, such as the spiral filter shown in figures 3, 4, and 8, or the perforated diaphragm shown in figure 5, to separate the tobacco from the mouthpiece.

15. Regarding claims 31 and 33, the filtering element of Arneson are inherently low sorption as they are not made of materials (glass fabric, rock wool) that provide significant sorption.

16. Claims 24, 32, 34, 37, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schut et al. (DE10044771 and English machine translation thereof) as applied to claims 1 and 25 above, and further in view of Edgar et al. (DE 4107025 A1, and English abstract thereof).

17. Schut et al. do not disclose a spacing insert. However, Edgar et al. disclose a tobacco cartridge and spacing insert (see abstract). It would have been obvious to one of ordinary skill in the art at the time of invention to use the tobacco cartridge and spacer of Edgar et al. in the cigarette of Schut et al. as the cigarette of Schut et al. does not contain tobacco and if a partial complement of tobacco was desired, the tobacco and spacer of Edgar et al. could be used.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL J. FELTON whose telephone number is (571)272-4805. The examiner can normally be reached on Monday to Friday, 7:30 AM to 4:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Phillip C. Tucker can be reached on 571-272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael J Felton/
Examiner, Art Unit 1791

/Philip C Tucker/
Supervisory Patent Examiner, Art Unit 1791